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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,557	04/17/2001	Rolf Heiland	81666	8401

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EXAMINER	
SINGH, ARTI R	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,557	HEILAND, ROLF	
	Examiner	Art Unit	
	Ms. Arti Singh	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks dated 01/14/05. Applicant's amendments to the specification overcome the rejection made in paragraph 3 and 4 of the previous office action. The previously made art rejection is also withdrawn in light of Applicant's response. The pending claims are 1-4 and 6-13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the claims that is the change from g/cm^2 to g/m^2 does not have support in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

> section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2002/0132547 A 1 issued to Grondin et al. Grondin et al. teach a nonwoven fabric/film laminate material is particularly suited for use as a "housewrap", or in like building construction applications. The laminate material comprises a spunbond polypropylene nonwoven fabric, and a breathable, polymeric film which is extrusion-coated onto the nonwoven fabric layer. Both the fabric layer and extrusion coating can be formed in a cost-effective manner on conventionally available processing equipment. By appropriate selection of the nonwoven fabric layer and film properties, the present laminate material acts as an effective barrier to liquid water and air infiltration,

while providing desirable permeability to water vapor (abstract). A laminate material embodying the principles of the present invention comprises a spunbond, polypropylene nonwoven fabric layer, and a monolithic, polymeric breathable coating applied to the nonwoven fabric layer. The breathable coating exhibits substantial impermeability to liquid water and air, while exhibiting significant permeability to water vapor. These characteristics of the present laminate fabric facilitate its use in building construction, particularly as a barrier "housewrap" for enveloping a building being constructed. The nonwoven fabric layer of the present laminate material has a basis weight between about 60 and 100 grams/meter ^{2}, preferably between 75 and 90 grams/meter ^{2}, and is formed from polypropylene having a viscosity, as measured in melt flow rate (MFR) of between about 6 and 16 MFR, with the range of 8 to 13 MFR being preferable. The polypropylene may include additives selected from the group consisting of ultraviolet stabilizers and thermal stabilizers, with the fabric exhibiting a strip tensile strength of at least about 50 N/cm, machine-direction, and at least about 35 N/cm, cross-direction, when tested in accordance with ASTM method D882, with an initial jaw separation of 10 cm, and a cross head speed of 5 cm/minute. The polymeric breathable coating of the present laminate material is extrusion-coated on the nonwoven fabric layer, and has a thickness of about 15 to 30 g/meter. The polymeric coating comprises, by weight, from about 35 to 90% of a copolymer selected from the group consisting of ethylmethylacrylate (EMA), ethylbutylacrylate (EBA), and ethylvinylacrylate (EVA), and from about 10 to 65% of a copolyester or thermoplastic elastomer selected from the group of copolyether-ester and copolyester-ester block copolymers. The breathable coating may further comprise one or more additives selected from the group consisting of ultraviolet and thermal stabilizers, polyolefin resin grafted with maleic anhydride, and resin modifier based on ethylene acrylate copolymer. More preferably, the acrylate copolymer is an ethyl methyl

acrylate or an ethyl butyl acrylate copolymer having a viscosity of between 3 and 12 MFR, as measured at 190.degree. C. and at 2.16 kg. Preferably, the breathable coating may comprise about 10 to 65% of a copolyester block copolymer where the butylene terephthalate hard segments and polyalkylene oxide soft segments alternate. The polymeric coating may also include stability-enhancing and adhesion-enhancing resin modifiers [paragraphs 0014-0016].

7. Grondin et al teach what is set forth above but do not expressively suggest the property of water permeability nor that their composite is a protective hood. With regard to the properties of water permeability the Examiner is of the position that no other structural or chemical features are claimed which may distinguish the present invention from that of the Grondin et al.'s invention, the presently claimed properties of water permeability are deemed to be inherent to the invention of Grondin et al. The burden is upon Applicant to prove otherwise. Note *In re Fitzgerald 205 USPQ 495*. Without a showing that evidences a difference between the prior art and the present invention, anticipation is proper. In addition, the presently claimed properties of water permeability would have been present once the composite of Grondin et al was provided. Note *In re Best*, 195, USPQ at 433, footnote 4 (CCPA 1977). In other words if structurally and chemically all other limitations have been met than the properties of permeability would also be met. Support of said assumption may be found in the use of similar materials. Grondin et al. use the same polypropylene nonwoven which can be coated with ethylene butyl acrylate, wherein the fabric (basis weight) and the coating weight also fall into the same range as that desired by Applicant, then it is safe to presume that the properties exhibited by such a composite, in this case that of water permeability would be the same also.

With regard to the preambular limitation of the claims, that is," A protective hood," the Examiner is of the position that; Applicant has failed to recite definite structure of said hood other than the description given on pages 1 and 5 of the instant specification, which in its broadest interpretation is simply a composite comprising a nonwoven with a coating. Additionally, when relying on the figures it appears to be a tarp, which in turn are generally known in the art to be composed of coated fabrics which are applied to metal substrates such as the surface of a car which is what Applicant envisions; thus the preambular language is not given weight for its intended use. Further, a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and that of the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. See ***In re Casey***, 152 USPQ 235 (CCPA 1967) and ***In re Otto***, 136 USPQ 458,459 (CCPA 1963). Here it is the Examiner's position that the invention of Grondin et al. is capable of being used as a protective hood for automobiles. The Examiner notes that the composite of Grondin et al is made as a barrier element for buildings which is the same thing a tarp for a car. Therefore, a skilled artisan would have found it obvious to employ the composite of Grondin et al. for use as a protective hood, motivated by the reasoned expectation of having a composite, which provides resistance to weather and abrasion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ms. Arti Singh
Primary Examiner
Art Unit 1771

Ars 04/04/05